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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,850	10/04/2000	Joshua J. Reiter	REITE0004	5969

24203 7590 08/21/2002

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/678,850

Applicant(s)

REITER, JOSHUA J.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 & 4. 6) ☐ Other: _____

Art Unit: 3629

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
2. The disclosure is objected to because of the following informalities:
 - A) applicant must update:
 - (1) the continuing data on page 1;
with the current status of each of the referenced applications, e.g., --now abandoned--,
or --now patent #?--, or --which is abandoned and now serial number #?--, etc.Appropriate correction is required.
3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
4. Claims 5, 10 & 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - 4.1 In regard to claims 5, 10 & 15, it is noted that these claims lack a section designated as "(e)". In this regard, applicant's designation of the next claim section as "(f)" is confusing because this gap in designations gives the appearance that something is missing from these claims. Hence, at line 2 of claims 5, 10 & 15, "(f)" should be --(e)--.
 - 4.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.
5. Claims 1-50 are rejected under the judicially created doctrine of double patenting over either:
 - A) claims 1-20 of U. S. Patent No. 5,819,241; or
 - B) claims 1-35 of U. S. Patent No. 6,178,411;

Art Unit: 3629

since the claims, if allowed, would improperly extend the "right to exclude" already granted in the above identified patents.

5.1 The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

- A) the scanning/reading of recipient information from an item;
- B) checking a data base for the recipient information;
- C) if a match is found, then applying targeted information to the item if not restricted by the recipient;
- D) if a match is not found, then applying general information to the item;
- E) updating a data base based on points (C) and (D); and
- F) determining the correct postage for the item.

5.2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5.3 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

5.4 Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. The following is an Examiner's Statement of Reasons for Allowance over the prior art:

- A) the prior art teaches for example:

Art Unit: 3629

(1) Storace et al (4,831,554) or Heinrich et al (5,471,925) which apply the same advertisement to each item to be shipped until the advertisement is changed; or

(2) Freytag (5,490,077 or 5,602,743) which apply the same advertisement to each item to be shipped for a particular cost center; or

(3) Wilkins (5,446,919) which searches a data base using a profile to apply targeted advertisements.

B) however, in regard to claims 1, 16, 20, 30 & 40, the prior art does not teach or suggest a mail processing system in which:

(1) the recipient data of an item to shipped is obtained from the item to be shipped;

(2) the obtained recipient data is then compared to a data base;

(3) if the data base contains matching information, then an associated targeted advertisement is applied to item to be shipped, otherwise a generic advertisement is applied; and

(4) updating the database to reflect the type of advertising applied to the item.

Claims 2-5, 17, 21, 31-39 & 41-48 are allowable for the same reason.

C) however, in regard to claims 6, 11, 18, 22, 24, 26 & 49, the prior art does not teach or suggest a mail processing system in which:

(1) the sender data of an item to shipped is obtained from the item to be shipped;

(2) the obtained sender data is then compared to a data base;

(3) if the data base contains matching information, then an associated targeted advertisement is applied to item to be shipped, otherwise a generic advertisement is applied; and

(4) updating the database to reflect the type of advertising applied to the item.

Claims 7-10, 12-15, 19, 23, 25, 27-29 & 50 are allowable for the same reason.

Art Unit: 3629

7. The examiner has considered the prior art cited in the parent applications which has been cited on the attached PTO-892, but not supplied to applicant.

8. The examiner has cited prior art of interest, for example:

A) Christensen et al (4,959,795) which discloses charging third part advertisers for advertising inserted into an item of mail.

B) Mayer (5,039,075), which discloses selecting targeted coupons for a recipient based on the recipient's address.

C) the Intellipost article, which disclose the sending targeted E-Mail to users over a network.

D) either Heiden et al (6,141,654) or Ryan, Jr. (6,173,274) or Heiden (6,408,286), which disclose charging third party advertisers based on advertisements that are applied to the exterior of an item of mail.

9. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

10.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

10.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

10.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

08/18/02


Edward R. Cosimano
Primary Examiner A.U. 3629